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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,797	12/20/2001	Ernest Marvin Thiessen	ICANS2/WAB	4804
7590 William A. Blake Jones, Tullar & Cooper, P.C. P.O. Box 2266 Eads Station Arlington, VA 22202			EXAMINER CHENCINSKI, SIEGFRIED E	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 11/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/022,797		THIESSEN ET AL.	
	Examiner		Art Unit	
	Siegfried E. Chencinski		3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/09/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**1. Claims 1 - 17 are rejected under 35 U.S.C. 101** because the claimed invention is not supported by either a tangible asserted utility, a concrete asserted utility or a well established utility. 1) regarding tangibility, independent claim 16 fail and dependent claims 8 and 17 fail because of containing the limitation to produce a concrete result by containing the limitation "other information" (claim 8) which is indefinite and "repeating the above steps any number of times" (Claim 17) which gives an unlimited number of iterations. The method step in claim 16 can also go on indefinitely, which fails to produce a tangible result. Further, 2) regarding concreteness in independent claims 1, 12 and 16, therefore impacting the claims 2-11 and 17, which depend therefrom, independent claims 1 and 16 require numerous subjective decisions to be made by the participants and by the moderator and the moderator system. Also, the participants are not required to make inputs and/or specific decisions. The dependent method claims merely add detailed steps within the uncertain process.

Regarding independent claims 1, 12 and 16, the judgments in each step represented by Figures 2 through 10 which are part of the guidelines to the practitioner for performing the generation of potential agreements by the participants in the process can only be made in a subjective manner. If the history of observed human behavior is a guide, the same individuals are likely to make different decisions in different sessions. Their own mental and emotional state will differ during different times. Their feelings of friendliness or antagonism, optimism or pessimism, compliance, rebelliousness or assertiveness level will fluctuate. In a sales or cost management scenario, these factors will affect their view of how successful they will be in an example of selling goals and budget will fluctuate. This is why many union-management agreements are arrived at in the early

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hours of long negotiation sessions when the negotiators on both sides are weary and more prone to agree to something just so they can go home and get some much needed sleep and also bring back a result to their superiors and/or stake holders.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**2. Claims 16 & 17 are also rejected under 35 U.S.C. 112, first paragraph.**

Specifically, since the claimed invention is not supported by either a tangible asserted utility, a concrete result or a well established utility for the reasons set forth above in the rejection under 35 USC 101, one skilled in the art clearly would not know how to use the claimed invention.

**3. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention because the specification contains methods and guidelines which can only be implemented in a subjective manner, thus preventing two ordinary practitioners of the art working independently from the possibility of duplicating the results of one another. Further, independent claims 1 and 16 require numerous subjective decisions to be made by the participants and by the moderator and the moderator system. Claim 16 also contains the limitation of "repeating the above steps any number of times", which gives it an unlimited number of iterations. Dependent claims 8 and 17 are similarly indefinite. "Other information" in claim 8, and "repeating the above steps any number of

times" in claim 17. Also, the participants are not required to make inputs and/or specific decisions. The dependent method claims merely add detailed steps within the uncertain process.

Regarding independent claims 1, 12 and 16, the judgments in each step represented by Figures 2 through 10 which are part of the guidelines to the practitioner for performing the generation of potential agreements by the participants in the process can only be made in a subjective manner. If the history of observed human behavior is a guide, the same individuals are likely to make different decisions in different sessions. Their own mental and emotional state will differ during different times. Their feelings of friendliness or antagonism, optimism or pessimism, compliance, rebelliousness or assertiveness level will fluctuate. In a sales or cost management scenario, these factors will affect their view of how successful they will be in an example of selling goals and budget will fluctuate. This is why many union-management agreements are arrived at in the early hours of long negotiation sessions when the negotiators on both sides are weary and more prone to agree to something just so they can go home and get some much needed sleep and also bring back a result to their superiors and/or stake holders.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph,** because numerous terms in the claims are relative terms which render the claims indefinite. The terms "level of satisfaction" and "preferences" in claim 1 are relative terms which render the claim indefinite. The terms " level of satisfaction " and "preferences" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Further, in independent claims 1 and 16, it is unclear that the stated goal in element a) of generating "at least one potential agreement" is guaranteed to be achieved. It is unclear how each party's preferences will be expressed (element b)). Regarding element d), it is unclear how potential agreements will be evaluated.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**5. Claims 1–17 are rejected** on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,495,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant admits in the specification that the instant application is based on the invention of Patent No. 5,495,412, but that it differs through the addition of an "improvement" by adding the feature which "allows decision makers to use blind bidding" (Specification, p. 3, ll. 27-28; p. 6, ll. 1-2). Aggarval et al. (US Patent 6,151,589) discloses the use of blind bidding prior to Applicant's invention. However, Applicant has

not claimed this improvement. The current claims are mere rewordings of the claims, and expansions through an extensive amount of non-functional descriptive material. Claim 1 in the application and claim 1 in the patent are each concerned with a computer-based method for assisting at least two parties in a negotiation making use of at least one programmed computer. Claim 16 of the application and claim 20 of the patent are each concerned with a computer-based method for assisting at least two parties in a negotiation making use a plurality of programmed computers, each independent from each other and each connected to a common separate central computer located at a neutral site. The claims in the parent patent make use of the Pareto optimal principle in independent claims 1(c) ii and 20 (g) and in dependent claim 16 ii). The Application's claims make use of Pareto optimization in dependent claims 3, 14, 15 and 17. An ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to reword the claims of the patent and to move the Pareto optimization features to dependent claims in order to produce the current application's claims. Further, the rejections on the merits of this application's claims are entirely based on the instant parent patent.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-17 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Thiessen (U.S. Patent No. 5,495,412).

**Re. Claims 16 & 12,** Thiessen discloses a computer-based method and apparatus for assisting at least two parties involved in a negotiation problem with any number of issues toward achieving an optimal mutually satisfactory agreement on decisions to be taken on one or more of said computer system (Abstract, ll. 1-5) comprising the steps of:

- a) providing a plurality of independent, separate computer systems, one for each of said parties, each said independent, separate computer system being programmed (Abstract, ll. 5-10);
- b) providing a central computer system located at a neutral site and a plurality of communication links connecting each of said independent, separate computer systems to said central computer system, said central computer system being programmed (Abstract, ll. 30-35);
- c) each party entering information into their corresponding one of said independent, separate computer systems (Abstract, ll. 5-7; Col. 5, ll. 42-50).
- d) transmitting said preference information from each of said independent, separate computer systems to said central computer system (Col. 5, ll. 48-50);
- e) said central computer system processing said transmitted preference information from all parties and generating any number of potential agreements to the said negotiation problem (p. 5, ll. 52-58);
- f) transmitting any said generated potential agreements and any other said information to be communicated to other parties from the said central, computer system to the appropriate said independent, separate computer systems (col. 5, ll. 58-60);
- g) each party submitting a response to said transmitted information and h) transmitting said response from each of said independent, separate computer systems to said central computer system; h); i) said central computer system declaring a tentative agreement; and j) repeating any of the above steps (col. 7, ll. 19-23). Thiessen also discloses confidentiality of information obtained from each party (Col. 6, ll. 27, 32). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's



invention to have seen it as obvious to have used the disclosures of Thiessen to develop a computer-based method and apparatus for assisting at least two parties involved in a negotiation problem with any number of issues toward achieving an optimal mutually satisfactory agreement on decisions to be taken on one or more of said computer system, motivated by to offer negotiating parties a means by which they, or a third party facilitator, could directly define and evaluate possible settlements that would result in mutual gains for negotiating parties (Thiessen, Col. 3, ll. 2-5).

The following claims language did not receive patentable weight because of being non-functional descriptive language (MPEP 2106):

- a) being programmed to receive and process information pertaining to each of said party's preferences on the outcome of each said issue involved in said conflict;
- b) said central computer system being programmed to receive preference information from each of said independent, separate computer systems and generate at least one potential agreement to the negotiation problem in response to entered preference information from each of said independent, separate computer systems;
- c) information to be communicated to other parties; and/or preference information; including bargaining range information, satisfaction function information for each of said issues, information defining tradeoffs between issues, and any number of potential agreements, which said potential agreements may be private or not and accepted or not; or any other information from which such said preference information may be derived;
- f) transmitting any said generated potential agreements and any other said information to be communicated to other parties from the said central, computer system to the appropriate said independent, separate computer systems;
- g) each party submitting a response to said transmitted information by changing preference information, creating new potential agreements and/or accepting any number of potential agreements transmitted from the said central computer system;
- h) any acceptances of any potential agreements in said response being kept confidential from any other of said parties;

i) if two or more parties have accepted the same potential agreement and transmitting that information to the appropriate said independent, separate computer systems; and  
j) any number of times.

**Re. Claim 1**, please see the rejection of independent claim 20. Claim 1 is the broader claim and the genus of the species emanating from it. One such specie emanating from claim 1 is claim 20. As such, claim 1 would have been obvious to the ordinary practitioner at the time of Applicant's invention on the basis for the reasons for the rejection of claim 20.

**Re. Claim 2**, Thiessen discloses a) entering into said computer system through said graphical interface, tradeoff preference information determining relative issue importance; and b) entering into said computer system through said graphical interface, proposals and/or potential agreements (which may be declared private) (Relative importance - Col. 3, ll. 55-57; Col. 42-46; private – Col. 6, ll. 27-37);

**Re. Claims 3-11, 17 & 13-15**, Thiessen discloses dependent claims 3-11 as these claims represent the iterations of the method disclosed by Thiessen as claimed in independent claims 1 and 16 (see the rejection of claim 16). Dependent claims 13-15 represent the apparatus for implementing the claims as established by independent claim 12. Further, dependent method claims 3 and 17 include Pareto optimization steps which are disclosed in Col. 6, ll. 54-60. Dependent apparatus claims 14 and 15 contain the apparatus enablement of the Pareto optimization steps.

### ***Response to Arguments***

7. Applicant's arguments received on August 9, 2007 with respect to claim 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is

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(571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

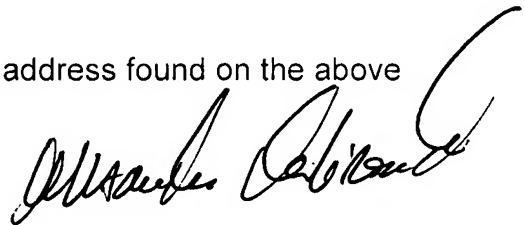
Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks, Washington D.C. 20231***

or Faxed to (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.



SEC

October 29, 2007

ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER